

5

Notice of Allowability	Application No.	Applicant(s)	
	10/797,968	MOORE ET AL.	
	Examiner	Art Unit	
	Tiffany A. Fetzner	2859	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 12/15/2005.
2. ☒ The allowed claim(s) is/are Amended claims 1-9 of the 12/15/2005 amendment.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|--|---|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date _____ |
| 3. <input checked="" type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date <u>12/15/2005</u> | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____ |

Examiner's Comment

Priority

1. The examiner notes that in the December 15th 2005 amendment and response that **applicant has acknowledged that the instant application has an effective date of March 11th 2004**, because although applicant has claimed the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c), applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. [1] as follows:

2. The later-filed application must be an application for a patent for an invention, which is also disclosed, in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

3. The disclosure of the prior-filed application, Application No. **10/319,088** fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. (i.e. All of the features of **independent claim 1** are not supported by the prior filed parent application.) Specifically there is no "drum shutter" feature in the parent application and no teaching in the parent for "a drum shutter connected to a waste bin, said drum shutter comprising first and second shutter arms; and removing a portion of the first shutter arm". Therefore the limitation of "a drum shutter connected to a waste bin, said drum shutter comprising first and second shutter arms; and removing a portion of the first shutter arm" from **independent claim 1**, is only an aspect of the applicant's instant **Continuation-In-Part** application, and is therefore only granted a **priority date of March 11th 2004**, for this feature / limitation. The **March 11th 2004**, date corresponds to the filing date of applicant's instant **Continuation-In-Part** application, and is considered to be the effective priority date for those claims which require the feature of "a drum shutter connected to a waste bin, said drum shutter comprising first and second shutter arms; and removing a portion of the first shutter arm" to be present within the claim, since that

Art Unit: 2859

is the date for which each of the features of applicant's claimed method are disclosed as a combination together. Because this new feature is an aspect of **independent claim 1**, it is also an aspect of all of applicant's **dependent claims 1-9**. Therefore, for purposes of this examination. **The effective priority date of the instant application is applicant's filing date of March 11th 2004.**

Drawings

4. The drawing objections from the last office action of September 14th 2005 are **rescinded** in view of applicant's amendments to the specification, which amend the specification to include the reference character(s) **102** shown in the originally filed **figures 3 and 4** but not mentioned in the original description.

5. The Official Draftsperson has also approved the drawings. [See the attached PTO 948 Notice of Official Draftspersons Review Form, which is attached to this Office action.

Claim Objections

6. The objections to **claims 1, 6 and 7** from the last office action of September 14th 2005 are **rescinded** in view of applicant's December 15th 2005 amendments to the claims, which amend these claims resolve the objections of record without adding new matter to the claims. **Amended Claims 1-9 of the December 15th 2005 amendment** are considered by the examiner to be free of new matter.

Response to Arguments

7. Applicant's arguments, with respect to the **Rogers et al.**, US Patent Application Publication **2005/0135836 A1** published June 23rd 2005, **filed December 18th 2003**. [See page 5 the last two paragraphs of the applicant's **Remarks** of the December 15th 2005 amendment and response, as well as the two page submission of the "showing of Common Ownership" both of which were filed December 15th 2005], have been fully considered and in view of the established common ownership the arguments to disqualify the **Rogers et al.**, reference from being an applicable prior art reference is persuasive.

8. The rejection of **Claims 1-9** under **35 U.S.C. 103(a)** as being unpatentable over **Rogers et al.**, US Patent Application Publication **2005/0135836 A1** published June 23rd

Art Unit: 2859

2005, filed **December 18th 2003** have been withdrawn, because this reference has been disqualified as prior art based upon **35 U.S.C. 103(c)**. [See the applicant's **Remarks** of the December 15th 2005 amendment and response, as well as the two page submission of the "showing of Common Ownership" both of which were filed December 15th 2005],

Allowable Subject Matter

The following is an examiner's statement of **reasons for allowance**:

9. With respect to **Amended Claim 1**, " A method of modifying a toner cartridge intended for operation in a first type of imaging device to operate in a second type of imaging device, the method comprising:

providing the toner cartridge adapted for operation in the first type of imaging device, said toner cartridge comprising **a drum shutter connected to a waste bin, said drum shutter comprising first and second shutter arms; and**

removing a portion of the first shutter arm in order to allow the toner cartridge to be inserted into the second type of imaging device."

10. This claim is considered to be allowable by the examiner because the prior art of record does not teach suggest or show the limitation of "...**a drum shutter connected to a waste bin, said drum shutter comprising first and second shutter arms; and removing a portion of the first shutter arm in order to allow the toner cartridge to be inserted into the second type of imaging device**", in combination with each of the other limitations set forth in this claim. Specifically the prior-art of record does not contemplate removing a portion of the first shutter arm, for a drum shutter connected to a waste bin, in order to allow the toner cartridge to be modified and inserted into a second type of imaging deice. However, it is the combination of each of the claim limitations taken as a whole which constitutes the novelty and non-obviousness of this claim

11. **Dependent claims 2-9** of the December 15th 2005 amendment and response are considered to be allowable by the examiner because they each depend of allowable **amended independent claim 1**.

Art Unit: 2859

12. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

13. The **prior art made of record** and not relied upon is considered pertinent to applicant's disclosure.

A) **Rogers et al.**, US Patent Application Publication **2005/0135836 A1** published June 23rd 2005, **filed December 18th 2003**. The examiner notes that this reference is applicable as prior art against the claims of the instant application because the instant CIP application has an effective US priority date of **March 11th 2004**, for the newly added CIP limitations of the claims.

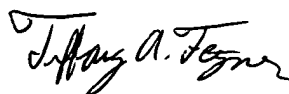
B) See all of the prior art references noted on the PTO 892 Notice of references cited from the **September 14th 2005** office action.

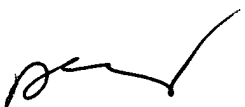
Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tiffany Fetzner whose telephone number is: (571) 272-2241. The examiner can normally be reached on Monday-Thursday from 7:00am to 4:30pm., and on alternate Friday's from 7:00am to 3:30pm.

15. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego Gutierrez, can be reached at (571) 272-2245. The **only official fax phone number** for the organization where this application or proceeding is assigned is **(571) 273-8300**.

16. Information regarding the status of an application may be obtained from the Patent Application information Retrieval (PAIR) system Status information for published applications may be obtained from either Private PMR or Public PMR. Status information for unpublished applications is available through Private PMR only. For more information about the PMR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PMR system contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


TAF
March 1, 2006


Diego Gutierrez
Supervisory Patent Examiner
Technology Center 2800